

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN KELLY JONES

Appeal No. 2000-0872
Application No. 08/852,119

ON BRIEF

MAILED

MAR 26 2001

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before THOMAS, BARRETT, and GROSS, Administrative Patent Judges.
GROSS, Administrative Patent Judge.

REMAND TO THE EXAMINER

In accordance with the provisions of 37 CFR § 1.196(a) and the Manual of Patent Examining Procedure (MPEP) § 1211 (7th ed., July 1998), this application is remanded to the examiner for an additional response.

Appellant relies on 37 CFR §§ 1.131 and 1.132 for overcoming rejections made under 35 U.S.C. §§ 102(e) and 103.

37 CFR § 1.131(a)(1) states, in pertinent part,

When any claim of an application ... is rejected under 35 U.S.C. § 102(a) or (e), or 35 U.S.C. § 103 based on a U.S. patent to another or others which is prior art under 35 U.S.C. § 102(a) or (e) and which substantially shows or describes but does not claim the same patentable invention, as defined in § 1.601(n) ..., the inventor of the subject matter of the rejected claim ... may submit an appropriate oath or declaration to overcome the patent or publication. (Underlining for emphasis)

Similarly, 37 CFR § 1.132 states, in pertinent part,

When any claim of an application ... is rejected on reference to a U.S. patent which substantially shows or describes but does not claim the same patentable invention, as defined in § 1.601(n) ..., affidavits or declarations traversing these references or objections may be received. (Underlining for emphasis)

Thus, oaths or declarations under both 37 CFR § 1.131 and 37 CFR § 1.132 are precluded if appellant and the patentee claim "the same patentable invention, as defined in [37 CFR] § 1.601(n)."

Here we find that the claimed inventions are clearly related. Accordingly, it is incumbent upon the examiner to determine whether or not appellant and Ross, the patentee of both patents applied in the rejections, are claiming "the same patentable invention, as defined in [37 CFR] § 1.601(n)." In making such a determination, the examiner must set forth a detailed two-way patentability analysis as defined in Winter v. Fujita, 53 USPQ2d 1234, 1243 (Bd. Pat. App. & Int. 1999). If the claimed invention of appellant anticipates or renders obvious the claimed invention of Ross and the claimed invention of Ross anticipates or renders obvious the claimed invention of appellant, then the claims are directed to "the same patentable invention" and appellant's affidavits are ineffective for overcoming the rejection.¹

¹ Appellant should note that for claims 1 through 14, 27, 28, and 31 through 49, all arguments in favor of patentability are based solely on the affidavits. We, therefore, assume that appellant concedes that Ross discloses the subject matter of these claims in each of the two patents.

If appellant and one or both of the patents are claiming the same patentable invention, then the possibility of an interference must be considered. The examiner must 1) ascertain the date appellant claimed the same invention and 2) ascertain the date appellant first disclosed the same invention (i.e., determine the effective filing date of the claimed invention). As this application is the most recent in a series of continuation-in-part (CIP) applications, the examiner must review each of the parent applications for the subject matter now claimed and found to be the same claimed invention as in the Ross patents.

If the patent issue date is more than one year prior to the presentation of claims to that invention by appellant, the examiner should make a rejection under 35 U.S.C. § 135(b) in accordance with MPEP § 715.05.² If the patent issue date is also more than one year prior to the disclosure of the presently claimed invention, then the examiner should also make a rejection under 35 U.S.C. § 102(b)/103. If the issue date is less than one year prior to the presentation of claims to the same invention, then the patent can be overcome only by way of interference. (See MPEP § 715.05.) If

² Since it is now more than one year after the issue date of each of the Ross patents, in accordance with 35 U.S.C. § 135(b), appellant has waived the right to copy claims from the Ross patents in order to initiate an interference.

the examiner decides that an interference should be initiated, then he should proceed following 37 CFR § 1.609. See also MPEP § 2309.

If appellant and one or both of the patents are not claiming the same patentable invention, then there is a possibility that appellant can swear back of the patents. Again, the examiner must start by determining the earliest date to which the claimed subject matter is entitled. If patent 5,444,444 to Ross qualifies as a § 102(b) reference, then it may not be sworn behind by a declaration under 37 CFR § 1.131. However, if patent 5,444,444 to Ross only qualifies as a 35 U.S.C. § 102(e) reference, it may be overcome by an appropriate declaration under 37 CFR § 1.131.³

Accordingly, it is ORDERED that the application is remanded to the examiner for the following actions:⁴

- to determine whether appellant and Ross, the patentee, claim "the same patentable invention" by applying the two-way patentability analysis of Winter v. Fujita;
- to determine the earliest effective filing date for appellant's presently claimed subject matter;

³ We note that some of appellant's declarations fail to meet the formal requirements set forth in 37 CFR § 1.68 as to the warning that "willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon."

⁴ We do not intend for this Remand to be construed as an invitation or opportunity to raise a new ground of rejection in a supplemental examiner's answer. See 37 CFR § 1.193(a)(2).

- if the examiner finds that appellant and Ross claim the same patentable invention:
 - if appellant claimed the same patentable invention within one year of the issue date of one or both of the Ross patents, to initiate an interference; or
 - if the same patentable invention was disclosed within one year but claimed more than one year after the patent issue date of one or both of the Ross patents, to make a new ground of rejection under 35 U.S.C. § 135(b); or
 - if the same patentable invention was both disclosed and claimed more than one year after the patent issue date of one or both of the Ross patents, to make a new ground of rejection under both 35 U.S.C. § 135(b) and 35 U.S.C. § 102(b)/103;
- if the examiner finds that appellant and Ross do not claim the same patentable invention:
 - if the Ross patent was filed more than one year before appellant's earliest effective filing date; to enter a rejection under 35 U.S.C. § 102(b)/103; or
 - if the Ross patent was filed less than one year before appellant's earliest effective filing date, to permit swearing behind the Ross patent with an appropriate declaration under 37 CFR § 1.131.

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This application by virtue of its "special" status requires an immediate action. See MPEP § 708.01(d) (7th ed., July 1998). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

JAMES D. THOMAS
Administrative Patent Judge


LEE E. BARRETT
Administrative Patent Judge

Anita Pellman Gross
ANITA PELLMAN GROSS
Administrative Patent Judge

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SCOTT A HORSTEMEYER
THOMAS KAYDEN
HORSTEMEYER & RISLEY
100 GALLERIA PARKWAY NW
SUITE 1500
ATLANTA, GA 30339